Attorney Docket No.: CA920000074US1 (7161-208U)   **PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of   :   Customer Number: 46320
                                              :
James LAU   :   Confirmation Number: 2828
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Application No.: 10/015,378   :   Group Art Unit: 2134
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Filed: December 12, 2001   :   Examiner: M. Simitoski
                                              :
For: METHODS, SYSTEMS, SIGNALS AND MEDIA FOR ENCOURAGING USERS OF
        COMPUTER READABLE CONTENT TO REGISTER

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated June 27, 2007.

        The Examiner's response to Appellant's arguments submitted in the Appeal Brief of

February 27, 2007, raises additional issues and underscores the factual and legal shortcomings in

the Examiner's rejection.   In response, Appellant relies upon the arguments presented in the

Appeal Brief of February 27, 2007, and the arguments set forth below.

In the paragraph spanning pages 6 and 7 of the Appeal Brief, Appellant reviewed the Examiner's cited passage in Meyer and stated the following:

> Appellant is unclear as to where Meyer precisely teaches using the imbedded executable code "to control the exact behavior of the execution environment of the content and track usage of the content." Appellant has been unable to find any mention of tracking usage of the content within Meyer. Moreover, referring to the Examiner's cited passage reproduced above, Meyer teaches that the Application Programming Interfaces (APIs) "control the exact behavior of the execution environment." Myer also teaches that an "execution environment is then invoked to begin execution of the execution code." However, Appellant is unclear as to where Meyer specifically teaches that the executable code stored within the content controls the APIs. Appellant, therefore, respectfully submits that Meyer cannot be relied upon to teach using the executable code within content to control the execution environment of the content, as asserted by the Examiner.

The Examiner's response to this argument is found on pages 7-11 of the Examiner's Answer. On pages 8-9, the Examiner reproduced certain passages within Meyer. Appellant's comments as to each of these cited passages is below:

Column 4, lines 7-19 -- This passage describes that a program (i.e., executable code) can be included within a media file (i.e., allegedly corresponding to the claimed non-functional descriptive content).

Column 4, lines 23-28 -- This passage **teaches away** from the claimed invention. Specifically, as underlined by the Examiner, Meyer describes that the "invention" can be used to "encourage the free and open distribution of the music." In contrast, claim 1 recites that the instruction codes are "operable to control further use of said content by said processor circuit." Appellant respectfully submits that one having ordinary skill in the art would recognize that "free and open distribution of the music" and controlling further use of the content are opposite goals.

Therefore, this teaching away, by Meyers, of the claimed invention constitutes evidence of nonobviousness.[1]

        Column 5, lines 46-49 -- This passage describes that supplement data can be extracted by the playback apparatus, but the relevance of this passage to the claimed invention is unclear.

        Column 10, lines 9-15 -- This passage describes that information, including a header, is transformed into a bit-stream and embedded into a MPEG audio file. Again, the relevance of this passage to the claimed invention is unclear.

        Column 10, lines 34-53 -- This passage describes that audio information is decoded and "then execution proceeds." Moreover, based upon a type of executable code, an appropriate execution environment is instantiated. The executable code is then executed simultaneously with the playback of the audio file.

        Appellant has already addressed this particular passage in the above-reproduced passage from the Appeal Brief. Moreover, upon further review, Appellant notes that the statement of "[b]ased on the MIME type of the executable code, an appropriate execution environment is instantiated" is unclear as to what the execution environment is appropriate for. Specifically, this passage is unclear as to whether the execution environment is appropriate for the executable code or appropriate for the audio file. In this regard, reference is made to column 7, lines 11-17 of Meyer and reproduced below:

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[1] In re Bell, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993), Specialty Composites v. Cabot Corp., 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988), In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986), In re Marshall, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

In the playback environment, moreover, the media player and the execution environment may communicate with one another, illustrated schematically in FIG. 2 by the SYNC line between the player and the data manipulation environment boxes, so that the execution of the supplemental data can be synchronized with the playback of the media file content.

Based upon this teaching it appears that the media player and the execution environment are separate. Therefore, the appropriate execution environment is instantiated not for the audio file (i.e., the non-functional descriptive content) but for the executable code itself. Also, Meyer teaching that the media player and the execution environment communicate with one another to synchronize execution of the supplemental data with the playback of the media file content does not constitute the executable code "[controlling] the exact behavior of the execution environment of the non-functional descriptive content," as alleged by the Examiner on page 9 of the Examiner's Answer.

On pages 9 and 10 of the Examiner's Answer, the Examiner asserted the following:

In combination, one of ordinary skill in the art finds motivation to modify Snyder's invention such that the tracker client program is embedded not within a parent program, as disclosed by Snyder, but within non-functional descriptive content such as a media file, by using the Meyer invention. This usefulness of this modification is clear from Meyer disclosing that, when executing the embedded program within the non-functional descriptive content, an execution environment is instantiated and used, via APIs, to control the exact behavior of the execution environment of the non-functional descriptive content. Further motivation is seen in col. 2, lines 17-21 of Meyer, which teaches that the embedded data supplements the non-functional descriptive content with e-commerce content presentations at the digital playback device (note again that Snyder's invention supplements functional descriptive content with an e-commerce application in the form of tracking software). Further explanation is given in the following paragraph.

As to the Examiner's first rationale to combine (i.e., "an execution environment is instantiated ..."), Appellant has already addressed this rationale. Specifically, Appellant is unclear as to where Meyer specifically teaches that the executable code stored within the content controls the APIs or the exact behavior of the execution environment of the non-functional descriptive content. Instead, of controlling the execution environment of the non-functional descriptive

content, Meyer appears to teach the executable code is used to <u>supplement</u> the non-functional descriptive content (see, e.g., column 2, lines 18-21; column 5, lines 45-49).

As to the Examiner's citation of column 2, lines 17-21 of Meyer, the Examiner has not set forth a reasonable explanation which supports a finding that one having ordinary skill in the art would recognize that the tracker program of Snyder is feature that would be considered to supplement and/or replace features directed to providing media content with "an extended capability to supplement their pre-pared presentations with added graphic interactive and/or e-commerce content presentations at the digital media playback apparatus," as described by Meyer. These features are very different in kind and implementation, and the Examiner has not established it is not obvious to include one because the other has been included.

In the paragraph spanning pages 10 and 11 (essentially almost all of pages 10 and 11), the Examiner further addressed the teachings found in column 10, lines 42-53. Appellant specifically notes the following assertion by the Examiner:

> When the executable code within the audio file is executed, the necessary environment is instantiated and it is that environment that can be used to control the exact behavior of the execution environment relative to the audio file. This environment, in the proposed modification, performs the usage tracking functions of Snyder. <u>The audio file is now under control of the execution environment, which receives its commands from the embedded code.</u> (emphasis added)

As already noted above, the "necessary environment" described by Meyer is not for the audio file, but instead, for the executable code. Thus, the Examiner's analysis is relying upon an improper characterization of the teachings of Meyer. The last, underlined sentence in the above-reproduced paragraph is unsupported. The audio file is not described by Meyer as being under control of the execution environment. At best, Meyers teaches that the playback of the audio file

and the execution environment are synchronized, and <u>even if</u> synchronization is considered "control," Meyer is unclear as to what entity (the media player or the execution environment) performs the controlling. Thus, the Examiner's primary rationale for combining the teachings of Snyder and Meyer (i.e., "to control the exact behavior of the execution environment of the audio file") is factually unsupported by the teachings of the applied prior art.

In the paragraph spanning pages 7 and 8 of the Appeal Brief, Appellant described an indicia of non-obviousness. On page 12 of the Office Action, however, the Examiner did not consider this indicia of non-obviousness. Instead, the Examiner improperly dismissed it.

Appellant's position is that given the teachings of the applied prior art, as a whole, one having ordinary skill in the art would not have arrived at the claimed invention. Appellant recognizes that Meyer was aware of the problem associated with unauthorized use of non-functional descriptive content (e.g., songs). However, when presented with this problem, Meyer's teachings were directed to an entirely different approach than that claimed. Referring to column 4, lines 23-28, Meyer advocates using the invention to embed advertising and e-commerce messages into the music so as to "encourage the free and open distribution of the music" (presumably generating revenue from the advertising instead of having a user pay for the music). On the contrary, the claimed invention is directed to using embedded executable code to control further use of the content through a registering process involving a key that is provided to the user. Thus, one having ordinary skill in the art looking to solve the same problem as solved by Appellant, based upon the teachings of Meyer, would have been led to a different approach

than that claimed. Therefore, the claimed invention is not obvious based upon the teachings of Snyder and Meyer.

For the reasons set forth in the Appeal Brief of February 27, 2007, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 27, 2007   Respectfully submitted,

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